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CENTRAL FAX CENTERAPR 17 2007 PATENT

Application No. 10/500,947
Amendment dated April 17, 2007
Reply to Office Action of November 17, 2006

REMARKS/ARGUMENTS

Claims 1-13 are pending.

Applicants note with appreciation that claims 6-9 are considered to be directed to allowable subject matter.

As previously discussed, the present invention is an improvement over prior art die plates for stamping machines in that it secures the metal impression layer 21, 24 to the plate steel back 20 with a compressible adhesive.

Die plates for foil stamping machines are typically rigid. However, the process of stamping requires some compressibility to ensure that a quality image is applied to the substrate. This usually takes the form of the packing behind the substrate. Further material is added behind the packing to correct low points in the die plate. Such material is usually added by glue or tape, and when the die plate is being replaced or repositioned, a flammable solvent must be used to remove the glue.

The claimed invention eliminates the need to add or insert material behind the packing to "make up" low spots while also ameliorating a crushing and/or distortion of the substrate by the stamping machine. The advances of the claimed invention provide substantial time and cost benefits over existing machines, eliminate the use of flammable solvents when changing or repositioning the die plates, and provide new security and anti-counterfeiting applications. These are important advances over the prior art and solve significant problems that currently exist in the art.

Claims 1, 5 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchison et al. U.S. Patent 6,584,893 ("Hutchison") in view of Hixon et al. U.S. Patent Application Publication 2005/0126407 ("Hixon"). The Examiner's rejection is respectfully traversed.

To properly establish *prima facie* obviousness under 35 U.S.C. §103, three basic requirements must be met: 1) there must be some suggestion or motivation, either in the

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references themselves, in the knowledge generally available to one of ordinary skill in the art, or in the nature of the problem to be solved, to modify the reference or to combine reference teachings (*In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)); 2) there must be a reasonable expectation of success (*In re Merck & Co., Inc.*, 800 F.2d 1091 (Fed. Cir. 1986)); and 3) the prior art reference(s) must teach or suggest all the claim limitations (*In re Royka*, 490 F.2d 981 (CCPA 1974)). Applicants submit that the rejection of independent claim 1 based on Hutchison and Hixon fails to meet these basic requirements.

In particular, applicants submit that even the proposed combination of Hutchison and Hixon fails to disclose or suggest "a compressible adhesive in contact with the impression layer and the steel back securing the impression layer to the steel back," as set forth by independent claim 1.

As acknowledged in the Office Action, Hutchison fails to disclose the use of a compressible adhesive in contact with both the impression layer and the steel back. Hixon fails to remedy this deficiency because it merely refers to a "cushioning element 38" that is "secured to support structure 34 by use of a suitable adhesive material, by mechanical fasteners [etc.]" (Hixon, paragraph 64, FIG. 3). Hixon's cushioning element 38, therefore, is not a compressible adhesive and, in fact, requires the application of separate adhesive or other means so as to be secured to its support structure. Therefore, even if Hutchison and Hixon were combined, as proposed by the Examiner, the combination would still fail to disclose or suggest all the elements of applicants' claim. Independent claim 1 is allowable for at least this reason.

Furthermore, neither Hutchison nor Hixon provides a motivation for one of ordinary skill in the art to modify or combine the references so as to teach applicants' claimed invention. In particular, Hutchison is directed to a magnetic means of securing the impression layer to the steel back, and Hixon is merely directed to the prior art method (described above) of securing compressible packing material using adhesives. Nothing in these two references provides a motivation or suggestion to practice applicants' novel approach of using a compressible adhesive to secure the impression layer to the steel back, and the Examiner has not identified any other sources for such a motivation.

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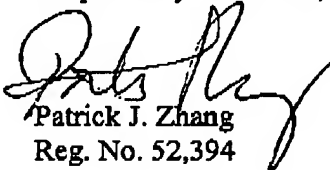
In view of the foregoing, independent claim 1 is in condition for allowance. Claims 2-13, which are variously rejected under §103 in view of Hutchison, Hixon, GB1,533,431, EP235,677, and Marbach U.S. Patent 4,256,026, are allowable at least because they depend from allowable claim 1.

CONCLUSION

Accordingly, applicants submit that all pending claims 1-13 are unobvious and allowable and request a formal notification thereof at an early date.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at (415) 273-8305 (direct dial).

Respectfully submitted,


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